

Hearing:
February 13, 1997

Paper No. 19
CEW

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

SEPT 23, 97

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Optische Werke G. Rodenstock

Serial No. 74/506,610

Alan E. Schiavelli, of Antonelli, Terry, Stout & Kraus for
applicant.

Amos T. Matthews, Trademark Examining Attorney, Law Office
108 (David Shallant, Managing Attorney).

Before Hohein, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Optische Werke G. Rodenstock has filed a trademark
application to register the mark SOLITAIRE for "coatings for
spectacle lens."¹

¹ Serial No. 74/506,610, in International Class 2, filed March 29, 1994. The application was filed with a claim of priority, under Section 44(d), based on the filing of a trademark application in Germany and with an allegation of a bona fide intention to use the mark in commerce. Applicant subsequently filed, under Section 44(e), a copy of the German registration issuing from the claimed German application and this application proceeded on that basis.

The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the mark SOLITAIRELENS, previously registered for "contact lenses,"² that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Applicant and the Examining Attorney have filed briefs. Applicant's counsel and the Examining Attorney appeared at the oral hearing before the Board. We affirm the refusal to register.

In a likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods. The Examining Attorney contends that the parties' marks are substantially similar and their goods are closely related. In particular, the Examining Attorney contends that SOLITAIRE is the dominant portion of registrant's mark; that LENS is a generic term in connection with registrant's goods and would be so perceived in registrant's mark, as LENS is a shortened version of the name of registrant's goods, contact lenses; that applicant's mark incorporates the dominant feature of registrant's mark and adds nothing to it; and that the goods of the parties are related and would be encountered by the same consumers

² Registration No. 1,776,341, issued June 15, 1993, to Tru-Form Optics, Inc., in International Class 9.

as both parties are in the business of providing optical products. In support of his position that the goods are related because coatings can be applied to both spectacles and contact lenses, the Examining Attorney submitted copies of excerpts from the LEXIS/NEXIS database, several examples of which follow:

"Get an anti-reflective coating for your regular eyeglasses or contact lenses. Any optometrist or optician can supply this." *The University of California, Berkeley Wellness Letter*, June 1995.

"The team . . . also launched a new brand of coating-treated contact lenses which stay cleaner longer as they prevent protein from tears sticking to the lenses and clogging them." *Daily Mail*, July 26, 1994.

"You can also get a 100 percent UV-blocking coating for regular eyeglasses. Even contact lenses can be coated to screen out ultraviolet light . . ." *The Washington Post*, July 5, 1988.

"The process is said to be ready for its first commercial tryout - preparing a scratch-resistant coating for contact lenses." *Chemical Engineering*, March 3, 1986.

On the other hand, applicant contends that there are differences in appearance, sound, meaning and commercial impression when the parties' marks are viewed in their entireties; that registrant's mark is a unitary mark and, as such, the suffix LENS would not be perceived solely as a descriptive or generic term; that the parties' goods are different; and that applicant's goods are directed to optometrists and opticians, who are sophisticated professionals. In its response of November 6, 1995,

applicant argues that "contact lenses have no coatings; only spectacle lenses can have coatings. It is submitted this is well know (*sic*) to opticians and optometrists. Not only are applicant's goods not the lenses themselves, but applicant's goods are coatings for spectacle (rather than contact) lenses."

Considering, first, the marks, we conclude that applicant's mark, SOLITAIRE, and registrant's mark, SOLITAIRELENS, create substantially similar overall commercial impressions. There is nothing in the record to indicate that SOLITAIRE is other than an arbitrary term in connection with both applicant's goods, coatings for spectacle lenses, and registrant's goods, contact lenses. There is no question that the term LENS is at least highly descriptive, if not generic, in connection with contact lenses. We find that SOLITAIRE is the dominant portion of registrant's mark; and that neither the addition of LENS to the term SOLITAIRE, nor the merger of SOLITAIRE and LENS into a single word, detracts from the dominance of the arbitrary term SOLITAIRE in registrant's mark. Applicant's mark is identical to the dominant portion of registrant's mark. The addition of LENS to registrant's mark does not distinguish the parties' marks. Rather, upon encountering both parties' marks in connection with their respective goods, consumers are likely to perceive that there is a

SOLITAIRE line of optical products of which SOLITAIRELENS contact lenses are one product.

Turning to the goods, we note that goods and/or services do not have to be the same or even competitive to support a finding of likelihood of confusion. It is enough if the goods and/or services in connection with which the marks are used are related in some manner such that they would be seen by the same individuals under circumstances that would cause those individuals to believe, albeit mistakenly, that the goods emanate from the same source. *See, General Mills Fun Group, Inc. v. Tuxedo Monopoly Inc.*, 204 USPQ 396 (TTAB 1979), *aff'd*, 648 F.2d 1335, 209 USPQ 986 (CCPA 1981) and cases cited therein. In this case, we find that applicant's goods, coatings for spectacle lenses, are closely related to registrant's goods, contact lenses. Both spectacles and contact lenses are optical products used primarily to correct vision or protect eyes. The evidence establishes that both spectacles and contact lenses are sold through, at least, opticians and optometrists; that opticians and optometrists also sell the coatings for such products;³ and that, contrary to applicant's contention, coatings are commonly applied to both spectacles and contact

³ Applicant's own German registration, which forms the basis of the application herein, is evidence that spectacles and coatings for spectacle lenses may emanate from the same source. The German registration identifies applicant's "line of business" as the "manufacture and sale of spectacles and spectacle frames." The goods

lenses, often for the same purpose (*i.e.*, to protect the wearer's eyes from ultra-violet light).

As neither party's goods contain any limitations as to the channels of trade, we must presume that the goods of applicant and registrant are sold in all of the normal channels of trade to all of the normal purchasers for such goods. See *Canadian Imperial Bank v. Wells Fargo*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987). Thus, we must presume that the goods of applicant and registrant are sold through the same channels of trade to the same classes of purchasers. Beyond evidence that goods of the type identified in the application and registration are available through opticians and optometrists, the record is silent as to the class of purchasers of the parties' goods, their sophistication, the cost of the goods, or the care with which purchases of the goods herein are made. There is no support for applicant's contention that the channels of trade for the parties' goods are limited to opticians and optometrists. In other words, there is no reason not to assume that the normal channels of trade include the marketing and sale of the goods herein under their respective marks, through opticians and optometrists, to the ultimate purchasers of spectacles and contact lenses.

identified in the registration include spectacle lenses, coated spectacle lenses, coatings for spectacle lenses and spectacles.

Thus, we are not persuaded by applicant's argument that confusion is not likely in this case because the purchasers of the parties' goods are sophisticated professionals in the optical field. We do not know from this record whether the goods are relatively expensive items or whether the purchase of such items is made by ordinary purchasers, either casually or after careful consideration. However, even if we were to conclude that the goods of the parties are marketed under their respective marks only to optical professionals, we note that highly educated and sophisticated professionals are not immune from confusion when the marks are as similar as these marks and the goods with which they are used are as closely related as the goods herein. *See, In re General Electric Company*, 180 USPQ 542 (TTAB 1973).

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark, SOLITAIRE, and registrant's mark, SOLITAIRELENS, their contemporaneous use on the closely related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods.

Serial No. 74/506,610

Decision: The refusal under Section 2(d) of the Act is affirmed.

G. D. Hohein

P. T. Hairston

C. E. Walters
Administrative Trademark Judges,
Trademark Trial and Appeal Board